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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/009,884      | 11/13/2001  | Hiroyuki Onishi      | U 013711-6          | 5111             |

140 7590 05/18/2004

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26 WEST 61ST STREET  
NEW YORK, NY 10023

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| EXAMINER |
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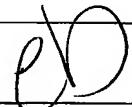
FLETCHER III, WILLIAM P

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1762

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |  |                                      |   |
|------------------------------|--|--------------------------------------|---|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/009,884       | <b>Applicant(s)</b><br>ONISHI ET AL. |   |
|                              | <b>Examiner</b><br>William P. Fletcher III | <b>Art Unit</b><br>1762              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-66 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Applicant's election, filed 4/19/2004, is acknowledged. Upon further review of the pending claims, it has become apparent that there are a greater number of species than were presented to applicant in the Office action mailed 3/18/2004. To clarify the record, a revised requirement for restriction and election of species is set-forth below. The examiner apologizes for any inconvenience such a revised requirement may cause.

#### *Election/Restrictions*

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-45, drawn to a surface treatment method.

Group II, claim(s) 46, drawn to a treatment agent.

Group III, claim(s) 47, drawn to a surface-treated product.

Group IV, claim(s) 48-66, drawn to a surface treatment apparatus.

3. The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

There is no technical relationship between these inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" means those technical features that define a contribution which each of the claimed inventions,

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considered as a whole, make over the prior art (see 37 CFR 1.475(a) and MPEP § 1875). All claims rely on the special technical feature of the surface treatment method of claim 1. Since this method is clearly anticipated *at least* by JP references 62-170382, 07-041726, 09-048180, 10-291377, 11-263052, 11-277924, 11-279440, and 11-279441 (all cited in applicant's IDS), it does not define a contribution over the prior art and, consequently, does not unify the claimed inventions.

4. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

- i. a sulfur compound treatment agent;
- ii. a nitrogen compound treatment agent;
- iii. a fluorine compound treatment agent;
- iv. a natural resin treatment agent;
- v. a synthetic resin treatment agent;
- vi. a treatment agent comprising water;
- vii. a treatment agent comprising organic solvent;
- viii. a treatment agent that is an aqueous solution which contains a water-soluble resin, a light resistance improving agent, and an ink fixing agent;
- ix. a treatment agent comprising oil and fat; and
- x. a treatment agent comprising an oil-form substance.

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Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

3. The claims are deemed to correspond to the species listed above in the following manner:

- i. for a sulfur compound treatment agent, claims 2, 3, and 8-10;
- ii. for a nitrogen compound treatment agent, claims 2, 4, and 8-10;
- iii. for a fluorine compound treatment agent, claims 2, 5, and 8-10;
- iv. for a natural resin treatment agent, claims 2, 6, and 8-10;
- v. for a synthetic resin treatment agent, claims 2, 7, and 8-10;
- vi. for a treatment agent comprising water, claims 2 and 8-10;
- vii. for a treatment agent comprising organic solvent, claims 2 and 8-10;
- viii. for a treatment agent that is an aqueous solution which contains a water-soluble resin, a light resistance improving agent, and an ink fixing agent, claims 11-19;
- ix. for a treatment agent comprising oil and fat, claims 20-29; and

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- x. for a treatment agent comprising an oil-form substance, claims 30-44.

The following claim(s) are generic: 1.

6. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

As above, since these treatment agents are clearly anticipated by *at least* applicant's cited JP references, they do not define a contribution over the prior art and are not unified.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*WPF 5/11/2004*

William P. Fletcher III  
Examiner  
Art Unit 1762

  
SHIVE P. BECK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700